

REMARKS

Prior to entry of the claim amendments presented above, claims 56-63 were pending in the application. Those claims have been canceled and claims 64-83 have been added to recite more clearly that which applicants regard as their invention. The cancellation of claims is made herein without prejudice or disclaimer of the subject matter recited therein, and applicants expressly reserve all rights to such subject matter, including the right to file continuation and/or divisional applications. The amendments are fully supported by the specification. Claims 64-83, including independent claims 64-66, are thus pending for reexamination and reconsideration, which are respectfully requested in view of the foregoing amendments and following remarks.

In the July 10, 2001 Office Action, claims 57, 59, 61, and 63 were rejected under 35 USC §112, second paragraph, as indefinite. Claims 56-63 were rejected under 35 USC §102(e) as anticipated by Robinson *et al.* ("Robinson") and by Queen *et al.* ("Queen"). The specific grounds for rejection, and applicants response thereto, are set out in detail below.

Support for Amendments

The added claims point out more clearly and distinctly that which applicants claim as their invention. Independent claims 64-66 are supported, *inter alia*, at page 4, third full paragraph and page 10, last paragraph, of the specification. Claim 67 is supported at page 10, last paragraph. Claim 68 is supported by original claim 27. Claim 69 is supported at page 38, Example 4.2. Claim 70 is supported at pages 38-39. Claims 71 *et seq.* are supported by the specification generally, at pages 22-29, and by original claim 22.

The Sequence Listing Amendment of 9/15/00

The Examiner observes that the sequence listing amendment of 9/15/00 could not be entered because of a discrepancy in page and line numbers. This discrepancy is due to the different pagination of the substitute sheets pursuant to PCT Rule 26 compared to the application as originally filed in the parent application (Serial No. 09/025,769). The amendment pursuant to corresponds to the pagination of the substitute sheets filed in the instant application. Accordingly, applicants respectfully request that the Amendment Pursuant to 37 CFR §§1.821-825 filed September 15, 2000 be replaced by the Amendment Pursuant to 37 CFR §§1.821-825 appended hereto.

Rejections under 35 USC §112, second paragraph

Claims 57, 59, 61, and 63 are rejected under 35 USC §112, second paragraph, as indefinite. Applicants respectfully submit that this rejection is rendered moot by the foregoing amendments and therefore request withdrawal of the rejection.

Rejections under 35 USC §102(e)

Claims 56-59 are rejected under 35 USC §102(e) as anticipated by Robinson *et al.* ("Robinson") and by Queen *et al.* ("Queen"). Applicants respectfully traverse the rejection.

It is axiomatic that, for a prior art reference to be anticipatory, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). Neither Robinson nor Queen describes every element of the claimed invention and, accordingly, neither reference can anticipate the claimed invention.

Thus, Robinson allegedly describes modular genes encoding antibodies. However, Robinson fails to describe either modular vectors where the vector modules are bounded by DNA cleavage sites that are unique within the vector, or nucleotides encoding immunoglobulins having the modular structure as instantly claimed. For at least this reason, this rejection is in error and should be withdrawn.

In addition, the "modular" genes described by Robinson have a structure that is quite different from that of the instantly claimed vectors. Thus, Robinson describes genes containing restriction sites between the variable region V, D, and J segments. The locations of these restriction sites was necessary because Robinson relied on genes encoding naturally occurring variable region fragments which were amplified by PCR to construct the "modular" antibody genes. The PCR-amplified products were ligated together using restriction sites present in the PCR primers. However, variable region V, D, and J segments bounded by restriction sites are quite different from vector modules bounded by unique cleavage sites, and are also quite different from framework and CDR regions bounded by unique cleavage sites, as recited in the instant claims. Accordingly, Robinson does not describe or suggest each and every element of the claimed invention, and withdrawal of the rejection respectfully is requested.

Queen suffers from the same deficiency as Robinson with respect to its lack of description of modular vectors as recited in the instant claims. In particular, Queen does not describe modular vectors where the vector modules are bounded by DNA cleavage sites that

are unique within the vector or nucleotides encoding immunoglobulins having the modular structure as instantly claimed. Accordingly, Queen does not describe or suggest each and every limitation of the claimed invention, and withdrawal of the rejection respectfully is requested.

CONCLUSION

In view of the above remarks and amendments, it is respectfully submitted that this application is in condition for allowance. Early notice to that effect is earnestly solicited. The Examiner is invited to telephone the undersigned at the number listed below if the Examiner believes such would be helpful in advancing the application to issue.

Authorization to charge the requisite fee of \$920.00 for a Three Month Extension of Time has been given in the above Request for Three Month Extension of Time.

If any additional extension(s) of time are required for the filing of this paper, applicants expressly petition for such extension(s) and authorize the Commissioner to charge any deficiency to Deposit Account 08-1641.

January 10, 2002

Date

Respectfully submitted,



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